REMARKS

Claims 1-54 were presented for examination, and claims 1-54 stand rejected. Thus, claims 1-54 are

presently pending in this application, of which claims 1, 15, 26, 36, 41, 47, and 54 are independent. Applicant submits that pending claims 1-54 are in condition for allowance.

The following comments address all stated grounds of rejection. Applicant urges the Examiner to pass the claims to allowance in view of the remarks set forth below.

Drawing Objection

The Examiner indicates in the Office Action Summary that the drawing(s) filed on December 7, 2001 are objected to by the Examiner. However, the Examiner does not describe any drawing objections in the Detailed Action section of the Office Action. In the previous Amendment and Response to Office Action filed on April 27, 2005, Applicant submitted replacement figures addressing the Examiner's drawing objections identified in the Office Action dated March 24, 2005. As such, Applicant submits the drawings are in a condition for acceptance.

Claim Rejections Under 35 U.S.C. §103

I. Claims 1-54 Stand Rejected under 35 U.S.C. §103

Claims 1-54 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Publication No. 2003/0229529 to Mui ("Mui") in view of U.S. Patent No. 6,601,016 to Brown ("Brown"). Applicant respectfully traverses this rejection.

A. Patentability of Independent Claims 1 and 41

Independent claims 1 and 41 are directed to a method and medium claim respectively. These independent claims recite a method for providing user profiles regarding users and fitness activities of the users, and examining the user profiles to match at least two selected ones of the users for a scheduled fitness activity. That is, the claimed invention examines user profiles to match at least a first selected user to a second selected user for a scheduled fitness activity. As such, the claimed invention provides a fitness enabling and motivation service which enables users to find a matched partner to participate in a scheduled fitness activity. Applicant contends that Mui in view of Brown does not teach or suggest each and every element of the claimed invention.

Mui in view of Brown fails to teach or suggest examining the user profiles to match at least two selected users for a scheduled fitness activity. Rather, Mui examines competencies of employees to match an employee to the competency level requirements of a business goal (see paragraph 1331, lines 1-3, Mui). For example, a business goal may require one employee having a desired competency level to work on achieving the business goal. Mui searches the competency profiles of the employees of the company to provide a list of employees from which to select an employee to assign to the business goal. The selected employee may be assigned to the business goal without assigning any other employees to the business goal. As such, Mui matches a user with a competency profile of a business goal instead of matching the user with another user for a scheduled fitness activity as in the claimed invention.

Even when the business goal of Mui is assigned to multiple employees, Mui is matching employees to the different competency level requirements of the business goal and not matching employees with each other. In Mui, the competency profiles of employees are not examined to match one employee by competency level with another employee by

competency level to provide a well-matched partner to a selected employee. In contrast, the claimed invention matches a first selected user to a second select user, and the selected users to the scheduled fitness activity. Instead of matching a first user with a second user for a scheduled fitness activity, Mui matches a first user to a first competency requirement and a second user to a second competency requirement. Therefore, Mui fails to teach or suggest examining the user profiles to match at least two selected ones of the users for a scheduled fitness activity.

In the Response to Arguments section of the Office Action, the Examiner indicates that the claim limitation of "for a scheduled fitness activity" is not given patentable weight because it is regarded as intended use. The examiner cites *Ex parte Masham,* 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) for the purpose of suggesting a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. The Examiner also cites *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963) for the purpose of suggesting a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Applicant respectfully points out to the Examiner that these cited cases are directed towards interpreting claim limitations of an apparatus type claim. However, the claimed invention is directed towards a method type claim with corresponding medium claims. As such, the Examiner cited cases concerned with the intended use of apparatus claims are not relevant to the patentability of the claimed invention. Therefore, Applicant submits the claim limitation of "for a scheduled fitness activity" must be evaluated and considered, just like any other

limitation of the claim, for what it conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

In the Office Action, the Examiner cites Brown for the purpose of suggesting one ordinarily skilled in the art might modify Mui to apply Mui for a scheduled fitness activity. However, Brown does not bridge the other factual deficiencies of Mui. As discussed above, Mui does not teach or suggest examining the user profiles to match at least two selected ones of the users for a scheduled fitness activity. As with Mui, Brown does not teach or suggest examining the user profiles to match at least two selected ones of the users for a scheduled fitness activity. Instead, Brown is focused on monitoring personal fitness indicators of a user on fitness equipment and storing the fitness indicators on a server. Brown does not discuss matching a first user with a second user for a scheduled fitness activity. Rather, Brown is concerned with monitoring and recording the personal fitness indicators of a particular user. Thus, Brown fails to bridge the factual deficiencies of the Mui reference.

Additionally, in the Office Action, the Examiner indicates Brown teaches the fitness activity features of the claimed invention because Brown discusses a fitness profile. However, the fitness profile of Brown does not teach or suggest the fitness activity features of the claimed invention for matching a first user with a second user. The fitness profile of Brown stores cumulative real-time data of fitness activity for a user over a particular period of time (see column 9, lines 1-14, Brown). For example, Brown's fitness profile may indicate a user exercised on a treadmill for 20 minutes and a rowing machine for 20 minutes. As such, the fitness profile of Brown is directed towards monitoring and recording personal fitness indicators from fitness equipment used by a particular user rather than for matching a first user with a second user for a scheduled fitness activity as in the claimed invention. Thus, Brown fails to teach or suggest the fitness activity features of the claimed invention.

Furthermore, there must be motivation or suggestion in the references or in the knowledge of one ordinarily skilled in the art to modify Mui in view of Brown. In the Office Action, the Examiner indicates one ordinarily skilled in the art might modify Mui in view of Brown to apply Mui to a different field related to fitness activity. The Examiner merely cites Brown because the disclosure of Brown refers to fitness activity. However, the test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures as a whole would suggest to one ordinarily skilled in the art. *In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).* The references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek, 163 USPQ 545 (CCPA 1969).* Applicant contends that the disclosures of Mui and Brown considered as a whole do not provide a suggestion or motivation to combine Mui in view of Brown.

Mui suggests to one ordinarily skilled in the art a workforce planning tool to address problems with planning, monitoring, and adjusting workforce performance in view of organizational goals. In contrast, Brown suggests to one ordinarily skilled in the art a personal fitness monitoring system for monitoring and recording personal fitness indicators to address limitations with exercise equipment, such as being boring to utilize and operating independently of each other. With the Mui reference in front of one ordinarily skilled in the art, Mui would not provide a suggestion or motivation to seek or combine the teachings of a personal fitness equipment monitoring system reference such as Brown. Likewise, one ordinarily skilled in the art would not find a suggestion or motivation in the teachings of the personal fitness equipment monitoring system of Brown to seek or combine the teachings of a workforce planning tool such as Mui. Thus, there is no suggestion or motivation in the references of Mui and Brown, or in the knowledge of one ordinarily skilled in the art to combine Mui in view of Brown.

For at least the above-discussed reasons, Mui in view of Brown fails to teach or suggest each and every element of the claimed invention. Claims 2-14 depend on and incorporate all the patentable limitations of independent claim 1. Claims 42-46 depend on and incorporate all the patentable limitations of independent claim 41. Thus, Mui in view of Brown fails to detract from the patentability of claims 2-14 and 42-46. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the Examiner's rejection of claims 1-14 and 41-46 under 35 U.S.C. §103.

B. Patentability of Independent Claims 15 and 47

Independent claims 15 and 47 are directed to a method and medium claim respectively. These independent claims recite a method for providing a user interface that enables a user to request a suitable partner for a fitness activity, conducting a search of candidate partners to locate a suitable partner, and returning to the user a list of any suitable partners. As such, the claimed invention enables a first user to find a suitable second user to participate together in a fitness activity. Applicant contends that Mui in view of Brown does not teach or suggest each and every element of the claimed invention.

Mui in view of Brown does not teach or suggest providing a user interface that enables a user to request a suitable partner for a fitness activity. Instead, Mui provides a user interface to find a user of a suitable competency and competency level to accomplish a business goal. The user interface of Mui is used to match an employee with a competency profile of a business goal rather than with another employee to partner with for a fitness activity. The user interface of the claimed invention enables a user to find a suitable partner with respect to the user for a fitness activity. In contrast to the claimed invention, the user interface of Mui enables a user to find a suitable person with respect to the competency

profile of the business goal. Therefore, Mui fails to teach or suggest providing a user interface that enables a user to request a suitable partner for a fitness activity.

In the Office Action, the Examiner cites Brown for the purpose of suggesting one ordinarily skilled in the art might modify Mui to apply Mui to a fitness activity. However, Brown fails to bridge the other factual deficiencies of the Mui reference. As with Mui, Brown does not teach or suggest providing a user interface that enables a user to request a suitable partner for a fitness activity. Rather, Brown is focused on personal monitoring fitness system to monitor and record personal fitness indicators from fitness equipment. Brown does not discuss providing a user interface that enables a user to request a suitable partner for a fitness activity. Instead, Brown provides an output interface of a monitoring device to provide personal fitness information relative to the particular user. Thus, Brown fails to bridge the factual deficiencies of the Mui reference.

For at least the above-discussed reasons, Mui in view of Brown fails to teach or suggest each and every element of the claimed invention. Claims 16-25 depend on and incorporate all the patentable limitations of independent claim 15. Claims 48-53 depend on and incorporate all the patentable limitations of independent claim 47. Thus, Mui in view of Brown fails to detract from the patentability of claims 16-25 and 48-53. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the Examiner's rejection of claims 15-25 and 47-53 under 35 U.S.C. §103.

C. Patentability of Independent Claim 26

Independent claim 26 is directed towards a method performed in a computer system to provide a web site including a matching facility and a scheduling facility. The matching facility identifies persons that are well-matched to a first user for a particular type of fitness activity. The scheduling facility schedules fitness activities among persons. The claimed

invention uses the matching facility to identify at least one person that is well-matched to the user for a first type of fitness activity, and uses the scheduling facility to schedule a first event of the first type of fitness activity between participants, including the first user and the well-matched person. Applicant contends that Mui in view of Brown does not teach or suggest each and every element of the claimed invention.

Mui in view of Brown fails to teach or suggest identifying at least one person that is well-matched to the user for a first type of fitness activity. Rather, Mui identifies a person that is matched with a competency requirement of a business goal. In contrast to the claimed invention, Mui does not identify a person that is well-matched to another person for a first type of fitness activity. Instead, a person of Mui is matched with a business goal and the competency requirements of the business goal. The competency profiles of users in Mui are not compared to each other to determine suitability between the users to participate together in a fitness activity. Thus, Mui does not identify a person that is well-matched to a user for a fitness activity. Therefore, Mui fails to teach or suggest identifying at least one person that is well-matched to the user for a first type of fitness activity.

In the Office Action, the Examiner cites Brown for the purpose of suggesting one ordinarily skilled in the art might modify Mui to apply Mui to a fitness activity. However, Brown fails to bridge the other factual deficiencies of the Mui reference. As with Mui, Brown does not teach or suggest identifying at least one person that is well-matched to the user for a first type of fitness activity. Instead, Brown provides for monitoring personal fitness indicators on fitness equipment and storing the fitness indicators on a server. Brown does not discuss identifying at least one person that is well-matched to the user for a first type of fitness activity. Rather, Brown is concerned with monitoring and recording the personal fitness indicators of a particular user. Thus, Brown fails to bridge the factual deficiencies of the Mui reference.

For at least the above-discussed reasons, Mui in view of Brown fails to teach or suggest each and every element of the claimed invention. Claims 27-35 depend on and incorporate all the patentable limitations of independent claim 26. Thus, Mui in view of Brown fails to detract from the patentability of claims 27-35. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the Examiner's rejection of claims 26-35 under 35 U.S.C. §102.

D. Patentability of Independent Claims 36 and 54

Independent claims 36 and 54 are directed to a method and medium claim respectively. These independent claims recite a method for prompting a participant in a fitness activity for feedback regarding a selected participant in the fitness activity. In response to the prompting, the feedback regarding the selected participant is obtained. The method makes information regarding the feedback available to parties that are considering scheduling a fitness activity with the selected participant. Applicant contends that Mui in view of Brown does not teach or suggest each and every element of the claimed invention.

Mui in view of Brown fails to teach or suggest prompting a participant in a fitness activity for feedback regarding a selected participant in the fitness activity, and making information regarding the feedback available to parties that are considering scheduling a fitness activity with the selected participant. Rather, Mui is concerned with obtaining employee performance reviews with respect to an employee's competency levels and progress towards assigned business goals. The employees of Mui are rated by feedback providers to provide ratings on competency levels and achievement of business goals. The type of feedback in Mui is not in regards to participation in a fitness activity by a participant of the fitness activity. In further contrast to the claimed invention, Mui also does not provide the employee feedback to parties considering scheduling a fitness activity but instead to

parties considering assigning the employee to a business goal. The employee feedback of Mui is not suitable or relevant to parties considering scheduling a fitness activity. Thus, Mui fails to teach or suggest prompting a participant in a fitness activity for feedback regarding a selected participant in the fitness activity, and making information regarding the feedback available to parties that are considering scheduling a fitness activity with the selected participant.

In the Office Action, the Examiner cites Brown for the purpose of suggesting one ordinarily skilled in the art might modify Mui to apply Mui for a fitness activity. However, Brown fails to bridge the other factual deficiencies of the Mui reference. As with Mui, Brown does not teach or suggest prompting a participant in a fitness activity for feedback regarding a selected participant in the fitness activity and making information regarding the feedback available to parties that are considering scheduling a fitness activity with the selected participant. Rather, Brown is concerned with providing feedback to a particular user from feedback indicators from fitness equipment monitored via monitoring devices. Brown does not discuss obtaining feedback about a participant in a fitness activity from another participant in the same fitness activity and making information regarding the feedback available to parties that are considering scheduling a fitness activity with the selected participant. Thus, Brown fails to bridge the factual deficiencies of the Mui reference.

For at least the above-discussed reasons, Mui in view of Brown fails to teach or suggest each and every element of the claimed invention. Claims 37-40 depend on and incorporate all the patentable limitations of independent claim 36. Thus, Mui in view of Brown fails to detract from the patentability of claims 37-40. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the Examiner's rejection of claims 36-40 under 35 U.S.C. §103.

CONCLUSION

In view of the remarks set forth above, Applicant contends each of the presently pending claims in this application is in immediate condition for allowance. Accordingly, Applicant respectfully requests the Examiner to pass the claims to allowance.

If the Examiner deems there are any remaining issues, we invite the Examiner to call the Applicant's Attorney at the telephone number identified below.

Respectfully submitted,
LAHIVE & COCKFIELD, LLP

Dated: September 9, 2005

By _____
Christopher J. McKenna
Registration No.: 53,302
Attorney For Applicant

Lahive & Cockfield, LLP
28 State Street
Boston, Massachusetts 02109
(617) 227-7400
(617) 742-4214 (Fax)